

APPLICANT: KLEIN, Steffan Gottfried  
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## **REMARKS**

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicant asserts that the present invention is new, non-obvious and useful. Favorable reconsideration and allowance of the claims is respectfully requested.

### **Status of Claims**

Claims 40-59 are pending in the application. Claims 40-49 and 52-59 have been amended.

Applicant respectfully asserts that these amendments add no new matter.

### **Response to Examiner's Comments/ Remarks**

In paragraph 5 of the Office Action titled Examiner's Comments/ Remarks, the Examiner states that certain limitations do not limit the scope of the claims.

Regarding claims 41 and 46, the Examiner states that clauses (e.g., whereby, thereby, wherein) merely state the results of the limitations of the claims and therefore do not limit the scope of the claims. Applicant respectfully disagrees.

Claim 41, as amended, includes, inter alia, "said indication of invalidity comprises an indication that the order critical data has been altered." Applicant respectfully asserts that the "indication that the order critical data has been altered" of claim 41 is not a result, but additional information. Adding such additional information in claim 41 to further define the indication of invalidity in claim 40 narrows claim 41 and thus, should be given patentable weight. Further, the indication that the data has been altered is functional and not merely descriptive, in the sense that it provides a useful and practical result.

Claim 46, as amended, includes, inter alia "wherein said product details include [ ] order critical data and comprising digitally signing the order critical data with a secret key." Applicant respectfully asserts that further defining said product details to include order

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critical data and adding a method step of digitally signing the order critical data with a secret key are both positive limitations and should be given patentable weight.

Regarding claims 48-51, the Examiner states that functional terms (e.g., for, configured to, and means for) are not given patentable weight in system claims because they fail to add any structural limitations. Applicant asserts that the claims include no instance of the terms “configured to” and Applicant has amended the claims to remove some instances of the term “for” to comply with the Examiner’s request.

However, Applicant respectfully disagrees regarding the use of “means for” in claims 48-51. MPEP section 2181(I) defines means-plus-function claims as follows:

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis: (A) the claim limitations must use the phrase "means for" or "step for;" (B) the "means for" or "step for" must be modified by functional language; and (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

Since each of the “means for receiving,” “means for verifying,” and “means for indicating,” limitations in claim 48 meets all three of these criteria, Applicant respectfully asserts that these limitations should be given patentable weight as means-plus-function claim limitations. Applicant notes that although the Examiner states that the claims are deficient for *not* adding structural limitations, means-plus-function claims require the opposite, i.e., that the “means for” language *not* be modified by structural limitations. The same is true for claims 49-51.

Regarding claim 59, the Examiner states the claim is missing the proper Beauregard language. In accordance with the Examiner’s observations, Applicant has amended claims 59 to include the proper Beauregard language, “when executed, causes the computer to . . .,” as defined by the Examiner.

## **CLAIM REJECTIONS**

### **35 U.S.C. § 112 Rejections**

In paragraph 6 of the Office Action, the Examiner rejected claims 46, 50, 53, and 57 under 35 U.S.C. § 112, second paragraph, as being indefinite.

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Regarding claim 46, the Examiner states that there is no antecedent basis for “the step of transmitting.” This limitation has been deleted from the claims so this rejection is moot. However, Applicant notes that since there is antecedent basis for “transmitting” in previously pending claim 40 (on which claim 46 depends), that the Examiner considers “a step of” a method limitation to be different than simply the method limitation itself. As this is not Applicant’s intention, Applicant has deleted all occurrences of “a step of” in the claims, as amended herein.

Regarding claim 50, Applicant requests clarification as to which limitations have antecedent basis problems.

“[T]he step of” is deleted in claims 53 and 57 for the same reasons as in claim 46.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 112.

### **35 U.S.C. § 102 Rejection**

In the Office Action, the Examiner rejected claims 40-43, 48, 52, 55, and 59 under 35 U.S.C. § 102(e), as being anticipated by Hughes et al. (U.S. Patent Application Publication No. 2008/0255982, “Hughes”). Applicant respectfully traverses this rejection in view of the remarks that follow.

Claim 40 as amended includes, *inter alia*,

[a] validation server receiving an electronic order of the customer, generated by [a] customer computer, over [a] public data network wherein the electronic order comprises order critical data that is protected from alteration and order data that is not protected; the validation server performing a verification of said order critical data in the electronic order.

Claim 48 as amended includes, *inter alia*,

receiving an electronic order of the customer transmitted over [a] public data network from [a] customer computer, wherein the electronic order comprises order critical data that is protected from alteration and order data that is not protected; [and] verifying means for verifying said order critical data in the electronic order.

Claim 52 as amended includes, *inter alia*,

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receiving from [a] customer computer over [a] public data network an electronic order of [a] customer, wherein the electronic order comprises order critical data that is protected from alteration and order data that is not protected; [and] verifying said order critical data in the electronic order.

Claim 55 as amended includes, *inter alia*,

generating an electronic order, wherein the electronic order comprises order critical data that is protected from alteration and order data that is not protected; and transmitting the electronic order over [a] public data network to a validation server that verifies said order critical data.

Claim 59 as amended includes, *inter alia*,

generating an electronic order of the customer wherein the electronic order comprises order critical data that is protected from alteration and order data that is not protected; and transmitting the electronic order over [a] public data network from the customer computer to a validation server that verifies said order critical data.

Applicant respectfully asserts that Hughes does not teach at least these features.

In particular, Hughes does not teach generating or receiving an electronic order comprising order critical data that is protected from alteration and order data that is not protected, as required in each of Applicant's claims 40, 48, 52, 55 and 59. In contrast to Applicant's claims having *both* protected *and* non-protected data in an electronic order, Hughes teaches "all messages to and from the processor may [] be encrypted using SSL" (paragraph [0050] of Hughes).

Furthermore, since Hughes teaches indiscriminately protecting *all* messages, no message of Hughes would ever have both protected and non-protected data, as required in each of Applicant's claims 40, 48, 52, 55 and 59. Accordingly, these claims are allowable over Hughes.

Applicant notes that he is acting as his own lexicographer in defining the term 'order critical data' to be, for example, in some embodiments, data which is 'critical to the integrity of an order, since alteration has the potential to result in loss of income to the merchant,' as defined on page 4 lines 3-5 of Applicant's Specification as filed. This term, with this

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meaning, which is in each of Applicant's claims 40, 48, 52, 55 and 59, is absent from Hughes.

Hughes is directed to methods and systems for supporting the trading of bonds using broker dealers as intermediaries, which is a very different application than that of the present invention. There is no teaching or suggestion anywhere in Hughes that orders for bonds contain 'order critical data', or that there is any manipulation of the content of the orders in Hughes. Nor is there any disclosure in Hughes of any means by which critical elements protecting the integrity of an order may be independently verified from the remaining non-protected content of the order, for example, to detect any tampering by a customer of the non-protected content by observing the protected content.

In addition, Hughes also does not teach a validation server that verifies the order critical data of an electronic order, as required in each of claims 40, 55 and 59. In paragraph [0079], Hughes teaches, an "order processing server 12, which validates ... the order." Although Hughes validates an order itself, which Applicant understands to comprise a formal validation to ensure, for example, that all required fields of the order are populated, Hughes does not teach or suggest validating protected order critical data, e.g. substantive content and values of fields having 'the potential to result in loss of income to the merchant', within the order.

Encryption via SSL (Secure Sockets Layer) addresses the issue of security of information in transit across an insecure network (e.g. the Internet), but does not address the issue of *trust* that comprises the object of embodiments of the present invention. Specifically, the protection of "order critical data" as distinct from "order data" in embodiments of the invention, as claimed, prevents a customer who is considered to be untrusted (see page 3 lines 22-25 of Applicant's Specification as filed) from modifying critical data, such as price, while still allowing the customer to set or modify other order data, such as delivery or payment details (see page 16 lines 24-28 of Applicant's Specification as filed).

Accordingly, claims 40, 55 and 59, as amended are allowable over Hughes.

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Each of claims 41-43, 48, and 52 depends from claim 40, and therefore includes all the limitations thereof. Therefore, Applicant respectfully asserts that claims 41-43, 48, and 52 are likewise allowable.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 40-43, 48, 52, 55, and 59 under 35 U.S.C. § 102.

### **35 U.S.C. § 103 Rejections**

In the Office Action, the Examiner rejected claims 44 and 49 under 35 U.S.C. § 103(a), as being unpatentable over Hughes in view of Carpenter et al. (U.S. Patent Application Publication No. 2004/0205003, “Carpenter”), claims 45 and 56 under 35 U.S.C. § 103(a), as being unpatentable over Hughes, claims 46, 47, 50, 51, 53, 54, 57 and 58 under 35 U.S.C. § 103(a), as being unpatentable over Hughes in view of Wasilewski (U.S. Patent Application Publication No. 2003/0018976, “Wasilewski”). Applicant traverses these rejections in view of the remarks that follow.

As discussed each of Applicant’s independent claims 40, 48, 52, 55 and 59 are allowable over Hughes. Each of claims 44-47, 49-51, 53, 54, and 56-58, depends, directly or indirectly, from one of claims 40, 48, 52 and 55, and is therefore likewise allowable over Hughes. Applicant respectfully asserts that none of Carpenter or Wasilewski nor Jang or Brendel (full cites for which are found on page 11 of the Office Action), alone or in combination, cures the deficiencies of Hughes. Therefore, claims 44-47, 49-51, 53, 54, 56-58 are allowable.

Furthermore, Applicant asserts that the use of Hughes as a reference under 35 U.S.C. § 103 is improper. Applicant asserts that Hughes does not teach data tampering or alteration, fraud, data integrity, or other terms of the technical field of the present Application, and that Hughes is in a different technical field than the present Application, which is, for example, in some embodiments, in the field of “identifying and preventing fraud in electronic commerce systems in which orders are placed over an insecure network,” as described in the section titled “field of the invention” on page 1, lines 4-6 of the Application as filed, and more specifically addressing the issues of security and trust that arise in client-side e-commerce shop implementations, as described in the section titled “background of the invention” on

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page 3, lines 22-32 of the Application as filed. Accordingly, it would not be obvious to combine Hughes with other references in this field.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claims 44-47, 49-51, 53, 54, and 56-58 under 35 U.S.C. § 103.

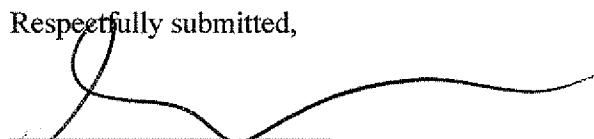
### **Conclusion**

In view of the foregoing amendments and remarks, Applicant asserts that the pending claims are allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Except for the fee for the Petition for Three Months Extension of Time, being paid separately, no additional fees are believed to be due in connection with this paper. However, if any such fees are due, please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



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